

not required (MPEP §803). The burden is on the Examiner to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Examiner has the burden of explaining why each group lacks unity with each other group specifically describing special technical features in each group (MPEP § 1893.03(d)).

The Office has asserted that Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

“the processes of Groups I and II defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The process of preparing carbonic ester clearly has different special technical features than that of preparing polycarbonate. Thus the two processes vary extensively and when taken as a whole result in vastly different processes.”

Annex B of the Administrative Instructions under the PCT at (b) Technical Relationship states:

“The expression “special technical features” is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).”

Applicants respectfully submit that the Examiner has not provided any indication that the contents of the claims interpreted in light of the description was considered in making the assertion of a lack of unity and therefore has not met the burden necessary to support the assertion.

Applicants respectfully submit that Rule 13.1 under Unity of Invention indicates that the inclusion of more than one invention in one international application is only permitted if all inventions are so linked as to form a single general inventive concept.

Applicants respectfully point out that each of the synthesis methods described in the Claims share a common character in that all provide a process with high yield without using phosgene or chlorine gas and without using a halogen-containing organic solvent as a reaction solvent. Therefore each of the synthesis methods share the common inventive improvement.

Annex B of the Administrative Instructions under the PCT at (b) Technical Relationship states:

“The expression “special technical features” is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).”

Applicants respectfully submit that the Examiner has not provided sufficient indication that the contents of the claims interpreted in light of the description was considered in making the assertion that the groups are distinct. Moreover, lack of unity has not been established and therefore the burden necessary to support an assertion of lack of unity has not been met.

Moreover, Applicants respectfully submit that the groups are actually related processes as described above and that MPEP §806.05(j) applies.

The MPEP (§806.05(j)) states that related product inventions are distinct if:

- “(A) the inventions *as claimed* do not overlap in scope, i.e., are mutually exclusive;
- (B) the inventions *as claimed* are not obvious variants; and
- (C) the inventions *as claimed* are either not capable of use together or can have a materially different design, mode of operation, function, or effect.”

Applicants respectfully submit that the Office has not demonstrated any of the indications of distinctness (A), (B) or (C) listed in MPEP (§806.05(j)).

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction.

Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully Submitted,

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